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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,270	06/26/2003	Michihiro Shibata	Q76017	3378
23373	7590	02/08/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			CHEN, TIANJIE	
			ART UNIT	PAPER NUMBER
			2656	

DATE MAILED: 02/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/606,270

Applicant(s)

SHIBATA, MICHIIRO

Examiner

Tianjie Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## ***Final Rejection***

### ***Drawings***

1. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because newly submitted drawings Figs 4 and 5 are not accepted for two reasons: (1) it contains new matter as described in following “new matter” rejection, (2) The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “another layer having a shape that is substantially the same as that of the transparent substrate” must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled

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"Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 4-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoigawa et al (JP 9-69239) in view of O'Brien (US 6,775,839).

Claim 1, Itoigawa et al shows an optical recording medium in Fig. 2, which includes; a transparent substrate 1 on the bottom having a center hole, a reflective layer 2, which is provided on the substrate at an outer side of a circumference of the center hole; a first adhesive layer 4 which is provided on the reflective layer at an outer side of a circumference of the center hole; one of another substrate 1 which is laminated on the adhesive layer has a shape that is the same as that of the transparent substrate, and another layer 2 having a shape that is substantially the same as that of the transparent substrate.

Itoigawa et al does not show a second adhesive layer which formed on a portion of the substrate, wherein the portion resides between an edge portion the center hole and whichever of an inner circumferential portion of a region having the reflective

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layer formed thereon and an inner circumferential portion of a region having the first adhesive layer formed thereon is closer to the center hole.

O'Brien shows an optical recording medium wherein a second adhesive layer 93 (Figs. 7-9; column 5, lines 59-61) which formed on a portion of the substrate, wherein the portion resides between an edge portion the center hole and whichever of an inner circumferential portion of a region having the reflective layer formed thereon and an inner circumferential portion of a region having the first adhesive layer formed thereon is closer to the center hole.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to add the layers taught by O'Brien into Itoigawa et al's device. The rationale is as follows: O'Brien teaches that this tag is used to act as an EAS (Electronic Article Surveillance) tag. One of ordinary skill in the art would have been motivated to add the tag to function as an EAS tag.

Claims 4 and 5; Itoigawa et al further show an adhesive, which is a slow-acting (the time to hardening is long after the bonding agent is applied, see ABSTRACT, SOLUTION section) and cation-curing ultraviolet ray-curable resin containing an epoxy as a main component thereof ([0013]).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to use the adhesive taught by Itoigawa et al for both first and second adhesive layer.

Claims 6-8, Itoigawa et al further shows that the thickness of the adhesive is 10-20 microns ([0013]).

Claim 9. Itoigawa et al further shows that adhesive layers formed by screen printing ([0013]).

Claim 10, Itoigawa et al shows that the substrate includes a polycarbonate ([0008]).

3. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoigawa et al (JP 9-69239) in view of O'Brien (US 6,775,839) as applied to claim 1, further in view of Takemura et al (US 5,809,007).

In Itoigawa et al and O'Brien's device, the second adhesive is used for adhering the Electronic Article Surveillance layer, but the width of the second adhesive was not specified.

Takemura et al shows an optical recording medium, wherein the ID signal is recorded in a radial area with a width between 0.5 to 3 mm. (Column 11, lines 39-41).

It would have been obvious at the time the invention was made to one of ordinary skill in the art to set the width of the second adhesive within the range of 0.5 to 3 mm, which includes the width falling in the range of 0.5 to 1.0 mm. The rationale is as follows: applicant recites a range for the second adhesive. However, no unexpected result has been disclosed from setting this range. One of ordinary skill in the art would be able to find a suitable width through optimization and experimentation. Takemura discloses area for recording ID signal, which functions similarly to the Electronic Article Surveillance. One of ordinary skill in the art would have been motivated to expect that the width found through experimentation would include the number taught by Takemura et al, which includes the width falling in the range of 0.5 to 1.0 mm.

***Response to Arguments***

4. Applicant's arguments filed 05/11/2005 have been fully considered but they are not persuasive.

Applicant argues: in O'Brien "layer constitutions in which an "EAS tag (91)" is fixed on either a protective layer (87) or a reflective layer (830 via an adhesive layer (93). See Figures 7-11 of O'Brien."

Examiner's position: In O'Brien an adhesive layer (93) is formed on substrate via a protective layer on substrate 80 (Column 5, lines 5-58). It reads on the claim 1.

***Conclusion***

5. The prior art made of record in PTO-892 form and not relied upon is considered pertinent to applicant's disclosure.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tianjie Chen whose telephone number is (703) 305-7499. The examiner can normally be reached on 8:00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

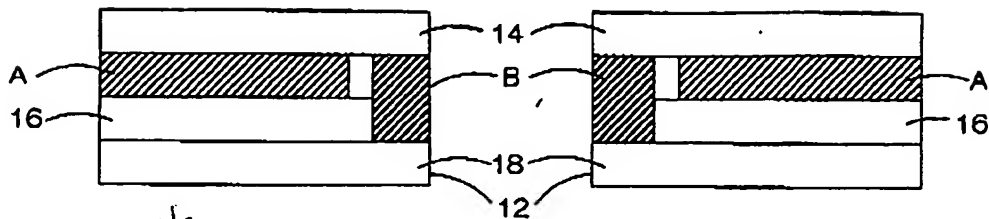
  
**TIANJIE CHEN**  
**PRIMARY EXAMINER**





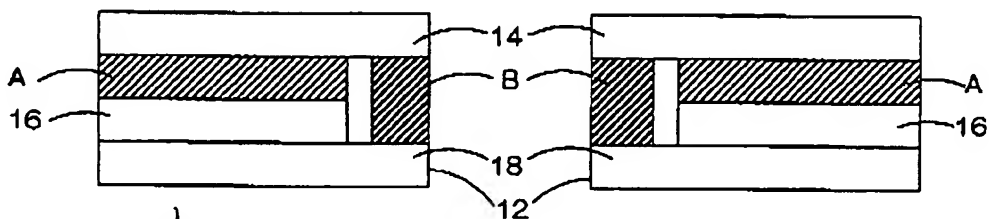
In re: Michihito SHIBATA  
App'n. No. 10/606,270  
Confirmation No.: 3378  
Filed: June 26, 2003  
For: OPTICAL RECORDING MEDIUM  
Sheet 1 of 1 (Figure 4 and Figure 5) New Drawing Sheet  
Any Dkt. Q76017  
SUGHRUE, MION, PLLC (202) 293-7060

FIG. 4



Do not enter it.  
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FIG. 5



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